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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/851,539

05/07/2001

William Willett

MAT 3D7

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7590

07/11/2002

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EXAMINER

SUHOL, DMITRY

ART UNIT

PAPER NUMBER

3712

DATE MAILED: 07/11/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/851,539

Applicant(s)

WILLETT, WILLIAM *cd*

Examiner

Dmitry Suhol

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-33 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>4</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 2-3, 21-23 and 31-33 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 2-3 and 23, it is unclear as to what is encompassed by the phrase "physically turned" since the motor physically turns the head or conversely the head can be physically turned by an external force. Examiner suggests changing the phrase to read "...physically turned by an external force...".

Regarding claims 3 and 21, the structural features/relationships encompassed by the phrase "...interposed the head and the base..." can't be determined, rendering the claim indefinite.

Regarding claims 31-33, there is no antecedent basis for "the predetermined response". It appears that the claims should be dependent from claim 26 instead of 25, therefore dependency to claim 26 is assumed for the remainder of the office action.

In view of the examples above, the applicant is required to carefully review all of the claims in order to correct those having the same defects but not specifically pointed to.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-6, 18-19 and 21-25 are rejected under 35 U.S.C. 102(b) as being anticipated by Terzian et al (U.S Patent No. 4,799,678). Terzian discloses an interactive doll containing all the elements of the claims including, a motor operatively connected to a head as required by claim 1 (fig. 4, element 130), a head rotatable relative to a base through a plurality of predetermined positions including a first head position as required by claim 1 (fig. 1, element 82) where a first head position is considered to be the left most position of the head, a head position assembly interposed between a head and a base, as required by claims 1 and 21 is read onto the mechanical assembly shown in figure 4, a contact surface as required by claim 1 (fig. 7, element 154), a position monitoring structure attached to a head as required by claims 1 and 22 (fig. 7, element 126) where it is considered that element 126 is attached to a head through the different gear/component and shaft assemblies as can be seen in figure 4, a safety mechanism as required by claim 2 (fig. 6 and fig. 4, elements 132 and 133) where it is considered that since the elements can “slip” that this feature allows the head to be physically turned through the turning of elements depicted in figure 6. Terzian further discloses a lower wafer (fig. 6, element 170), an upper wafer (fig. 6, element 180), a biasing structure interposed between the lower and upper wafer as required by claims 3 and 23

is read onto fig. 6, element 179 since it biases the head assembly into a position as shown in fig. 4 by holding shaft 144 in a non-pivotal relationship relative base 24. Terzian further discloses a stopping surface as required by claim 4 (fig. 7, element 118), at least one limit switch as required by claim 5 (fig. 7, element 126), a position monitoring structure being operatively attached to a processor as required by claim 6 (fig. 13, element 310), a base configured to disguise a power source as required by claims 18 and 24-25 (fig. 1, element 24), a body mounted on a base having a size that is not in proportion to a base as required by claim 18 (fig. 1), a motor driven head, as required by claim 18 (fig. 1, element 82), operatively connected to a power source (col. 2, lines 47-57) and not in proportion to a body (fig. 1). A first motor configured to rotate a head relative to a body, as required by claim 19, is shown in figure 4 as element 130.

Claims 7-9 and 11-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Leyden. Leyden discloses an animated doll containing all the elements of the claims including with reference to claim 7, a first body part (fig. 4 and col. 6, lines 1-4) operatively connected to a first motor with a first limit switch (fig. 8, element 39) and a second limit switch (fig. 8, element 39a) for signaling different positions of a first body part, and a second body part (fig. 4, element 36) operatively connected to a second motor (figs. 4 and 8, elements 10 and 12, respectively) with a third limit switch (fig. 8, element 39) and a fourth limit switch (fig. 8, element 39a) for signaling different positions of a second body part. Fig. 8 shows the velocity servo (fig. 4, element 10) employed in the movement of the eyelid (36), the head (fig. 4) and the jaw (37). A body as required

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by claim 7 is considered to be inherent in the doll disclosed in by the reference. A first body part being a head, as required by claim 8, is show in figure 4. A second body part being an eyelid, as required by claim 9, is shown in figure 4, element 36, where the eyelid is considered to be the portion above the eyelash. A processor adapted to control motion of a first body part and a second body part, as required by claim 11 is clearly described in figure 5, element 49 and by the circuitry in figure 9. Each limit switch actuating a position signal to a processor as required by claim 12 is shown in the circuitry of figure 9 and 5 and described in col. 6-7, lines 46+ and 16-28, respectively. The body parts being able to move independently is considered inherent since the servo circuits operate independently through signals from the processor.

Claims 26-28 and 31 rejected under 35 U.S.C. 102(b) as being anticipated by Weiner. Weiner discloses a sound producing toy doll containing all the elements of the claims including a communication port operatively coupled to a doll as required by claim 26 (fig. 14 and col. 6, lines 9-12), a processor operatively coupled to a communications port as required by claim 26 (col. 2, lines 58-64), a power assembly coupled to a doll as required by claim 26 (col. 6, lines 13-17), a communication port on a hand as required by claim 27 (fig. 14, element 165), external components being a plurality of hand held devices as required by claim 28 (col. 6, lines 9-12), and predetermined responses including a pre-recorded speech emitted by a speaker coupled to a doll as required by claim 31 (col. 6, lines 1-17).

Since the above references include all of the structural elements of the claims they are presumed to be inherently capable of all of the claimed functions, especially since it has been held that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchinson*, 69 USPQ.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 10 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Leyden. Although Leyden shows a motor for the eyelid and a jaw located in a first body part Leyden does not explicitly show a first motor contained in a first body part as required by claim 10 nor a base as required by claim 17. However, it would have been obvious to one having ordinary skill in the art, at the time of the claimed invention, to include the motor for the head (first body part) in the head for the purpose of ease of construction and a base to support a doll on a surface in an upright orientation, for the purpose of giving a doll the ability to stand for added realism and since such base construction in dolls is well known in the art. It is further considered that the location of

the motors is an obvious choice of design in that the applicant shows no advantage or critical need for the specific location.

Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Terzian in view of Leyden. Terzian does not teach an eye assembly having movable eyelids, however Leyden discloses an animated doll which teaches eyelids with a motor configured to move the eyelids from an open position to a closed position (fig. 4). It would have been obvious, in view of Leyden, to manufacture the device of Terzian with an animated host /doll capable of moving its eyelids for the purpose of increased realism and interest.

Claims 29-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weiner in view of Lebensfeld et al. Although Weiner discloses all the elements of the claims as stated above, the reference fails to teach a communication port in a torso of a doll as required by claim 29 and external components being a plurality of removable clothing as required by claim 30. However, Lebensfeld discloses a sound producing toy doll, like that of Weiner, which teaches a communication port in a torso of a doll (figs. 2-3 and col. 5, lines 1-2) and external components being a plurality of removable clothing (col. 7, lines 36-45). Therefore it would have been obvious to one having ordinary skill in the art, at the time of the claimed invention, to manufacture the doll of Weiner with a communication port in a torso of a doll and external components being a plurality of

removable clothing for the purpose of providing an interactive interesting doll for increased interest and excitement to a child playing with it.

Claims 26 and 32-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Leyden in view of Weiner. Leyden discloses a toy doll, which teaches a rotatable head operatively attached to a motor as required by claim 32 (cols. 4-5, lines 67-68 and 1-3, respectively) and motor driven movable eyelids operatively attached to a motor as required by claim 33 (fig. 4, element 36). Weiner teaches a doll eliciting a predetermined response, such as movable body parts, based on external components (col. 6, lines 1-29) and controlled by a processor, as stated above. Therefore it would have been obvious to modify the doll of Leyden to produce predetermined responses, including turning of a head and movement of eyelids, to external components, where the responses are controlled by a processor for the purpose of providing amusement to a user, added realism and having the ability to be conventionally modified, as taught by Weiner (col. 1, lines 44+).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dmitry Suhol whose telephone number is 703-305-0085. The examiner can normally be reached on Mon - Friday 9am-5:30pm.

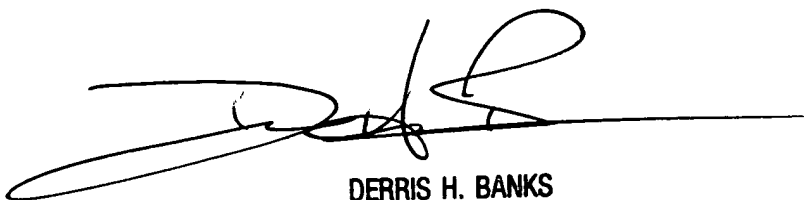
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached on 703-308-1745. The fax phone numbers

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for the organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

ds
July 9, 2002

A handwritten signature in black ink, appearing to read 'D. Banks', with a long horizontal line extending to the right.

DERRIS H. BANKS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700